

REMARKS/ARGUMENTS

CLAIM REJECTIONS – 35 USC § 103

U.S. Pat. No. 6,040,272

The Examiner has rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Riego, et al., U.S. Patent No. 6,040,272 in view of Esposito, U.S. Patent No. 4,822,407.

Reconsideration is respectfully requested.

Esposito is concerned with an oil dilutant that can penetrate bark and carry certain herbicides along with it. The dilutant is used in combination with oil-soluble industrial herbicides and emulsifiable industrial herbicides. See column 3, lines 15-16. The diluent is composed of lecithin, a hydrocarbon filler, and a mixture of emulsifiers, pine oils or terpenes, and heavy aliphatic mineral oils.

Riego is concerned with aqueous herbicidal compositions. See column 2, line 64. These compositions include “water-soluble herbicides.” See column 3, line 55.

While the Examiner relies on *In re Kerkhoven*, 205 U.S.P.Q. 1069, 1072 (CCPA 1980),¹ Applicant notes that *In re Kerkhoven* is distinct from the present situation. Namely, the two compositions that were combined by Kerkhoven required no more than mixing together two conventional spray-dried detergents. As a result, the court found that their combination to form a third composition was *prima facie* obvious.

In contradistinction, the combination proposed by the Examiner is not merely the mixing together of two conventional compositions. In fact, the combination that the Examiner proposes would require the mixing together of two compositions that are incompatible with one another, which one skilled in the art would not be inclined to do. As noted above, Esposito is concerned with oil-based compositions or oil-based

¹ Applicant notes that the Examiner cited 206 U.S.P.Q. 1069, 1072, but Applicant believes that the same was a typographical error and address 205 U.S.P.Q. 1069 in lieu thereof.

emulsions while Riego is concerned with aqueous-based compositions. As those skilled in the art appreciate, the herbicides (particularly glyphosate) employed by Riego are water-soluble. See column 3, line 55. These herbicides are dissolved in an aqueous medium to form the composition. Esposito, on the other hand, makes no reference to aqueous-based compositions or compositions wherein the active ingredients are dissolved in water².

Besides the purpose of penetrating bark, the Examiner has provided no reasoning to support the combination of Esposito and Riego. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

As additional proof that one skilled in the art would not be inclined to combine the teachings of Esposito and Riego, reference is made to the Declaration of Mr. Todd O'Connell, which is submitted herewith. Mr. O'Connell, who has extensive experience in both agricultural chemicals and organic-based chemicals, explains that the organosiloxanes employed by Riego would not be compatible with the Esposito compositions.

In an effort to emphasize the distinction, the claims have been amended to recite "aqueous insecticide or plant growth regulator composition." Support for this amendment can be found throughout the Application including page 9, line 15 of the written description.

Additionally, claims 23-25 have been added to specify particular insecticides and plant growth regulators. As those skilled in the art understand, these insecticides and plant growth regulators are not oil soluble or emulsifiable. Instead, these plant growth regulators and insecticides are water soluble.

While the claimed invention is clearly patentable over the combination of Riego and Esposito, the Applicant also maintains that the claimed invention is patentable over the combination of Riego with water-soluble insecticides and/or plant growth regulators. Indeed, the record is devoid of any teaching or suggestion in the art to combine water-

² As an aside, those skilled in the art appreciate that there are vast differences between water emulsions

soluble insecticides and/or plant growth regulators with the teachings of Riego. The Applicant maintains that the teaching of Riego is limited to the Application herbicides because there is no teaching or suggestion that the organosiloxanes described therein could be employed to achieve the through-bark penetration of any other chemical such as an insecticide or a plant growth regulator. The Applicant was surprised that the organosiloxanes taught by Riego could likewise be employed with insecticides and plant growth regulators to achieve through-bark penetration of the insecticides and plant growth regulators. In fact, others in the industry have likewise been surprised by the results achieved. Their surprise, however, should not be a surprise when the level of skill in the art is properly considered. Those skilled in the art understand that the use of surfactants in agricultural chemicals can be unpredictable. As a result, one could not predict that the use of particular surfactants in certain formulations (e.g. herbicides) would be useful for achieving similar results when other target chemicals are employed. In support of this position, the Declaration of Franklin E. Sexton is provided herewith.

and aqueous compositions, and therefore any reference within Esposito to water emulsions is insignificant.

CONCLUSION

It is respectfully submitted that all pending claims are in condition for allowance. Accordingly, Applicants request early and favorable reconsideration in the form of a Notice of Allowance.

The addition of claims 23-25 is offset by the cancellation of claims 8, 10, and 14, and therefore no fee is believed due with this Response except for the Extension fee.

If necessary to affect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to affect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 18-0987 (Docket #: QST.P.US0002).

Respectfully submitted,



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